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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,222	01/23/2004	Jack I. Shugart	506401-0059	9135

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EXAMINER	
ROYDS, LESLIE A	

ART UNIT	PAPER NUMBER
1614	

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/764,222	Applicant(s) SHUGART, JACK I.	
	Examiner Leslie A. Royds	Art Unit 1614	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: *2*.
   Claim(s) rejected: *1-19*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:

    _____
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

CHRISTOPHER S. F. LOW
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Leslie A. Royds
Patent Examiner
Art Unit 1614

23APR06

Continuation of 3. NOTE:

The proposed after-final amendment intends to change originally filed dependent claim 2 to an independent claim to an injectable euthanasia composition comprising the mixture of a euthanasia formulation in an amount sufficient to produce euthanasia and a taste aversive agent, wherein said taste aversive agent is provided in a concentration sufficient to render said composition aversive to an animal when ingested or inhaled and wherein said animal is a person and said composition is aversive to a person when ingested or inhaled. The amendment to the claim raises a new issue under 35 U.S.C. 112, second paragraph, insofar as the claim is drawn to a broad limitation ("wherein said taste aversive agent is provided in a concentration sufficient to render said composition aversive to an animal when ingested or inhaled) directly followed by a narrow limitation ("wherein said animal is a person and said composition is aversive to a person when ingested or inhaled"). It is not clear which limitation is intended to limit the scope of the claim.

Regarding such limitations, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in Ex parte Wu, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of Ex parte Steigewald, 131 USPQ 74 (Bd. App. 1961); Ex parte Hall, 83 USPQ 38 (Bd. App. 1948); and Ex parte Hasche, 86 USPQ 481 (Bd. App. 1949).

Applicant further presents arguments against the rejection made under 35 U.S.C. 103(a) over Sawyer '775 in view of Baker, Oshlack, Minkoff, Komer and Sawyer, stating that the cited references do not teach alone or in combination the addition of a taste aversive agent into a euthanasia formulation. Applicant is clearly considering the references individually, but is reminded that the references are relied upon in combination and are not meant to be considered as if in a vacuum. The test for obviousness is not whether the entire invention as presently claimed is expressly taught or suggested by any one single reference; rather the test is what the combination of art would have reasonably taught and suggested to the skilled artisan. For this reason, Applicant's argument that the references do not teach alone or in combination the inclusion of a taste aversive agent into a euthanasia formulation is not found persuasive because the cited references clearly teach the inclusion of denatonium benzoate into toxic compositions in order to deter inappropriate consumption of the toxic substance. Considering the highly toxic nature of a euthanasia formulation, the use of such an agent in a euthanasia formulation intended for animals would have naturally commended itself to one of ordinary skill in the art motivated to protect animals not intended for the composition from accidental ingestion.

Applicant relies on the declaration of Inventor Shugart in support of the assertions that there is no suggestion or motivation that a taste aversive agent would have been chemically compatible and chemically stable; that a mixture containing a euthanasia formulation and taste aversive agent that remained in a jar or vial for an extended period of time would separate and thus not allow for a correct dosage of the formulation to be measured; or that the addition of such an agent would diminish the effectiveness of the formulation and/or would interfere with the lidocaine in the formulation. However, such assertions are unsubstantiated by any evidence. Applicant has failed to present any examples, data or evidence of a euthanasia formulation in the absence of the taste aversive agent and compared such a control to the presently claimed euthanasia formulation and how Applicant's invention resolves these concerns existing in the art at the time of the invention by creating a formulation that overcomes these issues. In addition, Applicant has not made clear on the record that these concerns that are asserted to be those that existed generally in the art at the time of the invention were actually appreciated by those other than the present inventor himself. Furthermore, while Applicant states that numerous chemicals are not compatible with euthanasia formulations and relies upon isopropyl alcohol as an example, Applicant has failed to provide any proof or evidence as to why the incompatability of isopropyl alcohol would have been representative of the same chemical incompatibility with denatonium benzoate.

In view of the foregoing, and with further reliance and incorporation by reference of the reasons set forth in the final rejection, the evidence and remarks that Applicant has provided in the instant after-final amendment fail to outweight the obviousness of the present invention in view of the references to Sawyer in view of Baker, Oshlack, Minkoff, Komer and Sawyer. As a result, the claims remain properly rejected and the amendments will not be entered.